

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 6 and 8 are presently pending before the Office, with claims 7 and 9 being canceled herein and claims 10-18 being withdrawn due to a restriction requirement. Applicant has amended the specification and the claims. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed February 17, 2006 and the references cited therein have been carefully studied by Applicant and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

The Examiner has requested that the related application section be updated to show the issuance of the patent from the parent divisional application. Applicant herein amends this section.

Relying on 35 U.S.C. §102(b), the Examiner has rejected claims 6 and 8 as being anticipated by JP 5-105739 or Koike et al.(US5157165) or Schreiber(US4668718) or the abstract for JP 7-74260, for the reasons outlined on pages 3 and 4 of the office action. Applicant respectfully traverses the rejection and requests reconsideration.

Applicant respectfully submits that it is important to note that, historically, the Office and the Federal Circuit has required that for a §102 anticipation, a single reference must teach (i.e., identically describe) each and every element of the rejected claim. The Office has steadfastly and properly maintained that view.

Applicant believes that the inclusion of the limitations of claims 7 and 9 respectively with claims 6 and 8 overcome this rejection.

Relying on 35 U.S.C. §102(b), the Examiner has also rejected claims 6 – 9 as being anticipated by Zupancic et al.(US553485) for the reasons outlined on page 4 of the office action. Applicant respectfully traverses the rejection and requests reconsideration.

(1) Zupancic's patent relates to an invention characterized in that a specific mono-substituted dicyandiamide is used as a curing agent for epoxy resin. Zupancic et al. found out that use of this compound brings about an effect that a solvent can be dispensed with. Zupancic's patent, therefore, is different in the object from the invention of the present application which aims at curing acceleration.

(2) The specification of Zupancic's patent describes a number of additives other than dicyandiamide. TEP and 2-ethyl-4-metylimidazole are also exemplified. However, TEP is exemplified merely as one of many chain extenders and 2-ethyl-4-metylimidazole merely as one of many catalysts. Moreover, amounts of TEP and 2-ethyl-4-metylimidazole to be used are not explicitly described in the specification.

(3) In spite of the fact above, the Examiner has rejected the claims of the present application as being “anticipated by Zupancic et al.”, because TEP was used in the amount within the range of 0.001-0.1 mol per mol epoxy group in Example 39, etc. of Zupancic’s patent.

However, Applicant respectfully submits that the Examiner may have misconstrued the Zupancic disclosure.

It is as the Examiner states that TEP is used in the amount within the range of 0.001-0.1 mol per mol epoxy group in Example 39 and so on. Zupancic’s patent, however, requires the use of a specific mono-substituted dicyandiamide as a curing agent, and such Examples should be understood based on the premise that mono-substituted dicyandiamide is used. Therefore, it is not permissible to understand the invention by picking up only a combination of epoxy resin and TEP from the Examples.

In addition, TEP is used in Example 39 with tetrabromobisphenol-A which is one of the other chain extenders. TEP is used with tetrabromobisphenol-A not only in Example 39 but also in other Examples as well.

In all the Examples of Zupancic’s patent, chain extenders are used in the amount of more than 0.1 mol per mol epoxy group, either when used alone or used in combination of plural chain extenders. For instance, in Example 39, tetrabromobisphenol-A and TEP, both of which are chain extenders, are used in total of about 0.19 mol, and in Example 37, tetrabromobisphenol-A is used alone in the amount of about 0.17 mol per mol epoxy group.

In other words, the basic concept of Zupancic’s patent is to use more than 0.1 mol chain extender per mol epoxy group.

Given this, it is wrong to understand the content rate of chain extender to 1 mol epoxy group by only focusing on TEP in Example 39 and so on. The amount of chain extenders used

should be considered in a total of TEP and all other chain extenders and it should not be considered only for TEP.

Further, although there actually exists an example in Zupancic's patent where TEP is used within the range of 0.001-0.1 mol per mol epoxy group on a calculational basis, there is no description at all as to why TEP is used in that amount. Much less, Zupancic's patent does not suggest nor even describe that curing is accelerated by using TEP in the amount within the range of 0.001-0.1 mol per mol epoxy group.

In the present invention on the contrary, it was found out that when TEP was used, curing was accelerated compared to when other phenols were used by using 0.001-0.1 mol TEP per mol epoxy group.

(4) As above, the present invention and Zupancic's patent are different in the technical concept and the object of each invention. Therefore, it is believed that it cannot be said that the present invention is "anticipated by Zupancic et al." just because the content rate happens to be the same.

Accordingly, each and every element of Applicant's claims have not been taught in that single reference. Applicant respectfully submits that amended claims 6 and 8 have not been anticipated by the Zupancic patent under 35 U.S.C. §102(b), and respectfully requests that such rejection be withdrawn.

CONCLUSION


Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicant respectfully submits that claims 6 and 8 are patentable over the art of record.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 943-9300 would be appreciated.

Very respectfully,

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